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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,403	04/18/2001	Thomas J. Kennedy III	P-5907 SLD 2 0236	7628

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,403

Applicant(s)

KENNEDY ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The IDS of 7/30/02 did not include copies of the references.

The benefit claim filed on 12/20/02 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition

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should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The isophthalic acid and terephthalic acids of claims 1 and 19 do not qualify as phthalic acid. "phthalic acid polyamide" must be construed as requiring units from phthalic acid. Any other interpretation would be repugnant to the ordinary meaning. Note that applicant (page 6 of spec.) clearly distinguishes between the three acid compounds.

Claim 30's "acrylate" is not understood. The specification does not add acrylate monomer to polyamide and ionomer.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the inclusion of an acrylate (presumably monomeric) to blends of polyamide and ionomer.

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Claims 1-7, 11, 15, 16, 18-24, 29 and 31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan '862 Patent.

Rajagopalan suggests two or three piece golf balls. At least one of the layers is a sulfonated or phosphonated ionomer optionally blended with a polyamide (col. 29, lines 51-53). The polyamide can be based on isophthalic acid (col. 30, line 55) or terephthalic acid (col. 30 line 52).

Claims 1-7, 11, 14-24 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J 10305116 Patent.

The reference blends ionomer and polyetheramide for use as golf ball covers. The polyetheramide also contains aromatic ester groups (see formula I).

Presumably the same interactions between the ionomer and polyamide will be present in the reference as is for applicant (page 8, lines 5-17).

Claims 1-7, 11, 14-24 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J62022841 Patent.

The reference produces golf ball covers of ionomer and an polyester amide from terephthalic acid (see registry No. 110485-64-8)

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan WO 98/40127 Patent.

Rajagopalan claims golf ball covers of 10-80% ionomer and 90-20% polyamide (claim 1). The polyamide can include units from terephthalic acid (page 15 line 4). The

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COR is high (Table II). Some of the ionomers used by Rajagopalan (i.e. surlyn 9320, 9020, 8320) are known to be terpolymer ionomers which are based on ethylene/acrylate/acid terpolymers (see applicant's Table 6). These ionomers have ester groups.

Claims 8-10 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Rajagopalan '862 Patent or J 10305116 or J 62022841 or Rajagopalan WO 98/40127 in view of Sullivan '304.

The primary references may not report compression or COR values for their balls. However, these values are conventional as shown by Sullivan's table (col. 23). It would have been obvious to ensure the balls of primary references have compression and COR values within normal parameters.

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melanson '140 Patent.

The reference clearly meets the claims.

Claim 17 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6384140. This is a double patenting rejection.

Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

Applicant argues the instant application is now a CIP of the Melanson patent and therefore Rajagopalan '862, J '116 and Rajagopalan WO 98/40127 do not qualify as prior art.

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Firstly, the priority claim was untimely. Secondly, even if the claim was timely, these references have effective date in 1998. Serial number 8-763070 does not support the aromatic polyamides now claimed. Therefore, applicant cannot have an effective date earlier than 3/10/00.

Melanson '140 is also prior art because the inventive entity is different than the instant application. Only the "commonly owned" statement will remove Melanson '140 as prior art.

Applicant gives no explanation why the double patenting rejection of claim 17 should be withdrawn.

Applicant argues J '841 does not contain a phthalic acid polyamide.

This is not convincing. Registry number 110485-64-8 is derived from components including a diamine and 1, 4 benzenedicarboxylic acid (this is terephthalic acid). A diamine will react with a diacid to form a polyamide.

The terminal disclaimer removes the obviousness double patenting.

Deleens does not blend his polyamide with ionomer or use it in a mantle layer. Bissonnette's ball does not qualify as solid (it is wound) and does not blend his polyamide with ionomer.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. Buttner/mn
March 13, 2003

David Buttner
DAVID J. BUTTNER
PRIMARY EXAMINER